

**REMARKS**

This is intended as a full and complete response to the Office Action dated October 21, 2004, having a shortened statutory period for response set to expire on January 21, 2005. Please reconsider the claims pending in the application for reasons discussed below.

In the specification, paragraphs 1, 2, 5, 23, and 30 have been amended to correct minor editorial problems.

Claims 1 – 30 are pending in the application. Claims 1 – 7 and 9 – 30 remain pending following entry of this response. Claims 1, 11, and 19 – 30 have been amended. Claim 8 has been cancelled. Applicants submit that the amendments do not introduce new matter.

**Claim Rejections - 35 U.S.C. § 112**

Claims 1-30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection of claim 1 is illustrative:

it is unclear [to the Examiner] as to the metes and bounds regarding how to handle a request asynchronously when it is a synchronous request. Examiner interprets claim 1 as a catalog server in a database management system that is unavailable and processes an asynchronous request for a unique identifier from a requesting entity.

Claims 11, 19, and 27 are similarly rejected. Applicants respectfully traverse the rejection. As amended, independent claims 1, 11, 19, and 27 reflect that a synchronous request, normally processed in a synchronous manner by a catalog server, may be processed asynchronously by determining whether a unique identifier identified in the synchronous request conflicts with a name in a name table. Applicants assert, therefore, that the claims are not indefinite. Accordingly, Applicants request that this rejection be withdrawn.

PATENT  
Atty. Dkt. No. ROC920000327US1  
MPS Ref. No.: IBM2K0327

### Claim Rejections - 35 U.S.C. § 101

Claims 19-26 stand rejected under 35 U.S.C. § 101. The Examiner suggests that Applicants "amend claims 19-26 to a 'computer-readable medium' in order to overcome the rejection based upon 35 U.S.C. § 101." Applicants accept the Examiner's suggestion and have amended the claims accordingly. Therefore, Applicants request that this rejection be withdrawn.

### Claim Rejections - 35 U.S.C. § 102

Claims 1-4, 7-8, 11, 17-19, 23, and 25-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Johnson et al.* (U.S. Patent No. 6,535,908, hereinafter *Johnson*).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Johnson* fails to disclose "each and every element as set forth in the claim," and thus, fails to anticipate the present invention. *Johnson* generally relates to "telecommunication systems, and in particular, [to] a system and method for searching and verifying a database of records, typically call records, generated during the testing of a telecommunications network." *Johnson* 1:7-11. *Johnson* fails to disclose a method for processing a synchronous request in an asynchronous manner when a catalog server is currently unavailable to process the request, and where a unique identifier identified in the request is available in a names table. The material cited by the Examiner discloses "a service manager process executing *asynchronously* for starting and stopping all system processes; at least one collector process executing *asynchronously* for collecting data records from the data streams and placing the data

Page 12

331894\_1

PATENT  
Atty. Dkt. No. ROC920000327US1  
MPS Ref. No.: IBM2K0327

records in a record queue; and, a store of one or more first pre-determined templates." *Johnson*, 2:1-6. (Emphasis Added). Thus, the service manager disclosed by *Johnson* is configured to *only* process requests in an asynchronous manner and not to process a request normally processed in a synchronous manner, in an asynchronous manner. Applicants, therefore, submit that claims 1-4, 7-8, 11, 17-19, 23, and 25-30 are patentable over *Johnson*. Withdrawal of the rejection is respectfully requested.

**Claim Rejections - 35 U.S.C. § 103**

Claims 5-6, 9-10, 12-16, 20-22 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Kardos et al.* (U.S. Patent No. 6,430,562, hereinafter *Kardos*). Applicants respectfully traverse the rejection.

Regarding claims 5-6, 9-10, 12-16, 20-22 and 24, each of these claims depends from one of independent claims 1, 11, 19, or 27. To establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP § 2143.03. Applicants submit that because *Johnson* fails teach the invention claimed in independent claims 1, 11, 19 or 27, the rejection of claims 5-6, 9-10, 12-16, 20-22 and 24 is obviated without the need for additional remarks.

Therefore, Applicants submit that claims 5-6, 9-10, 12-16, 20-22 and 24 are patentable over *Johnson* in view of *Kardos*. Withdrawal of the rejection is respectfully requested.

PATENT

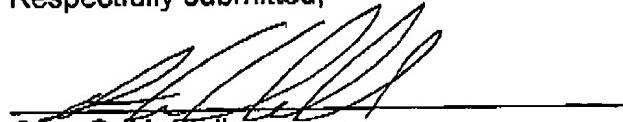
Atty. Dkt. No. ROC920000327US1

MPS Ref. No.: IBM2K0327

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Gero G. McClellan  
Registration No. 44,227  
MOSER, PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicants

Page 14

331894\_1